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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/653,595	08/31/2000	Ruth Marie Tritz	025213-9023-01	4590
23409 7590 10/08/2008 MICHAEL BEST & FRIEDRICH LLP 100 E WISCONSIN AVENUE Suite 3300 MILWAUKEE, WI 53202			EXAMINER SUBRAMANIAN, NARAYANSWAMY	
			ART UNIT 3695	PAPER NUMBER
			MAIL DATE 10/08/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

09/653,595

**Applicant(s)**

TRITZ ET AL.

**Examiner**

Narayanswamy Subramanian

**Art Unit**

3691

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 June 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-9, 26-32 and 40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9, 26-32 and 40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 August 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/C)
- Paper No(s)/Mail Date 7/24/08
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This office action is in response to applicants' request for continued examination filed on June 20, 2008. Applicants are requested to note the Examiner's new art unit number (**AU 3695**) in their reply to this office action. Amendments to claims 1 and 9 and cancellation of claims 41-49 have been entered. Claims 1-9, 26-32 and 40 are pending and have been examined. The objections to the drawings, rejections and response to arguments are stated below.

#### ***Drawings***

2. The drawings submitted with this application on August 31, 2000 are objected to by the examiner. This application has been filed with informal drawings, which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.

#### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-9, 26-32 and 40 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In particular, claims 1 and 9 rejected under 35 U.S.C. § 112, first paragraph, because the specification does not provide a written description disclosure to support the claimed limitation of "inputting the credit bureau data and the account information to a risk model"

(emphasis added). Dependent claims are rejected by way of dependency on a rejected independent claim.

The art rejections given below are interpreted in light of 35 U.S.C. § 112, first paragraph rejections discussed above.

***Claim Rejections - 35 USC § 101***

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 9 and 26-32 are rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory Subject matter.

35 USC 101 requires that in order to be patentable the invention must be a "**new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof**" (emphasis added).

Claims 9 and 26-32 are drawn to "a computer-readable medium storing computer-readable instructions for evaluating a financial account applicant, the instructions directing the computer to perform the acts of: accessing credit bureau data for the applicant; accessing account information for the applicant; inputting the credit bureau data and the account information to a risk model; generating a score for the applicant from an output of the risk model; and determining whether to open the financial account based on the score". As such the claimed invention is directed to a judicial exception to 35 U.S.C. 101 (i.e., an abstract idea, natural phenomenon, or law of nature) and is not directed to a practical application of such judicial exception because the claims do not require any physical transformation and the invention as claimed does not produce a useful, concrete, and tangible result.

The Court of Appeals for the Federal Circuit issued opinions in *State Street Bank & Trust Co. v. Signature Financial Group Inc.*, 149 F. 3d 1368, 47 USPQ2d 1596 (Fed. Cir. 1998) and *AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352, 50 USPQ2d 1447 (Fed. Cir. 1999). These decisions explained that, to be eligible for patent protection, the claimed invention as a whole must accomplish a practical application. That is, it must produce a “useful, concrete and tangible result.” *State Street*, 149 F.3d at 1373-74, 47 USPQ2d at 1601 02. To satisfy section 101 requirements, the claim must be for a practical application of the § 101 judicial exception, which can be identified in various ways: (a) The claimed invention “transforms” an article or physical object to a different state or thing. (b) The claimed invention otherwise produces a useful, concrete and tangible result, based on the factors discussed below.

The USPTO’s official interpretation of the utility requirement provides that the utility of an invention has to be (i) specific, (ii) substantial and (iii) credible. See MPEP § 2107. The computer readable medium claims 9 and 26-32 of the claimed invention is inoperative and therefore lacks utility as discussed below.

Claims 9 and 26-32 of the disclosed invention is inoperative and therefore lacks utility. Claims 9 and 26-32 are drawn to “a computer-readable medium storing computer-readable instructions for evaluating a financial account applicant, the instructions directing the computer to perform the acts of: accessing credit bureau data for the applicant; accessing account information for the applicant; inputting the credit bureau data and the account information to a risk model; generating a score for the applicant from an output of the risk model; and determining whether to open the financial account based on the score”. The computer readable medium is interpreted broadly to include an intangible medium. Claims 9 and 26-32 merely

recite elements of a computer readable medium ("code segments" correspond to software program elements and not tangible hardware components) without showing any ability to realize functionality of the recited elements (i.e. functional descriptive material per se) and therefore is rendered inoperative lacking any utility. Note that a computer (or software program) code cannot by itself perform the underlying function until it is loaded on some computer readable memory and accessed by the computer (or a processor). Functional descriptive material, per se, is not statutory. This is exemplified in *In re Warmerdam* 31 USPQ2d 1754 where the rejection of a claim to a disembodied data structure was affirmed. Thus a claim to a data structure, per se, or other functional descriptive material, including computer programs, per se, is not patent eligible subject matter.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-9, 26-32 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al (US Patent 6,088,686) in view of Basch et al (US Patent 6,119,103).

Claims 1, 4, 5, 9, 28, 29 and 40, Walker teaches a method and a computer-readable medium storing computer-readable instructions for automatically evaluating a financial account applicant for a financial institution, comprising the acts of: electronically accessing credit bureau data for the applicant (See the entire document of Walker especially Abstract, Column 1 lines

33-40, Column 2 lines 1-21 and Column 3 lines 49-54); electronically accessing account information for the applicant (See the entire document of Walker especially Abstract, Column 1 lines 33-40, Column 2 lines 1-21 and Column 3 lines 49-54); electronically generating a score for the applicant (See the entire document of Walker especially Abstract, Column 1 lines 33-40, Column 2 lines 1-21 and Column 3 lines 49-54); and determining whether to open the financial account based on the score (See the entire document of Walker especially Abstract, Column 1 lines 33-40, Column 2 lines 1-21 and Column 3 lines 49-54). The step of accessing credit bureau data for the applicant is inherent in the disclosure of Walker. The computerized system of Walker implies a computer-readable medium storing computer-readable instructions for performing the steps listed in the claim.

Walker does not explicitly teach the steps of inputting the credit bureau data and the account information to a risk model and generating a score for the applicant from an output of the risk model.

Basch teaches the steps of inputting the credit bureau data and the account information to a risk model and generating a score for the applicant from an output of the risk model (See the entire document of Basch especially Figure 1 Column 5 lines 11-16, 21-29, Column 6 line 64 - Column 8 line 2 and Column 9 lines 22-37). Basch receives credit bureau data (See the entire document of Basch especially Column 7 lines 64-66) and account information (See the entire document of Basch especially Column 7 lines 15-29) which are input to the Financial risk prediction system (FRPS). Scores are generated using the predictive models already created by the system. A computer-readable medium storing computer-readable instructions for generating a score and the score being a numerical score is inherent in the disclosure of Basch. Considering

demographic data including income and home ownership in making decisions is old and well known in the art.

It would have been obvious to one with ordinary skill in the art at the time of the current invention to include these steps to the disclosure of Walker. The combination of the disclosures taken as a whole suggests that Financial Institutions would have benefited from the early warnings about the risks associated with opening an account.

Claims 2, 3, 26 and 27 Walker teaches a method and a computer- readable medium storing computer-readable instructions of claims 1 and 9 respectively, wherein the act of determining whether to open the financial account includes the acts of establishing electronic guidelines for the financial institution and comparing the guidelines against the score to evaluate whether to accept the application and further comprising the acts of establishing electronic guidelines for the financial institution and comparing the guidelines against the score to evaluate whether to offer additional products and services of the financial institution to the applicant (See Walker Column 2 lines 1-38). The steps of establishing electronic guidelines and comparing the guidelines against the score are inherent in the disclosure of Walker.

Claims 6-8 and 30-32, Walker does not explicitly teach the steps of performing a preliminary database search, denying the applicant if the preliminary database search establishes that the applicant had prior problems with their accounts or obtaining one.

Official notice is taken that the steps of performing a preliminary database search, denying the applicant if the preliminary database search establishes that the applicant had prior problems with their accounts or obtaining one are old and well known in the art. These steps help financial institutions screen applicants who may be bad risk for the financial institution.



It would have been obvious to one with ordinary skill in the art at the time of the current invention to include these steps to the disclosure of Walker. The combination of the disclosures taken as a whole suggests that Financial Institutions would have benefited from early screening of applicants who may be bad risk for the financial institution.

***Response to Arguments***

9. In response to Applicant's assertion "Basch does not cure the deficiencies of Walker. Basch does not disclose a computer- implemented method of automatically evaluating a financial account applicant for a financial institution comprising inputting the credit bureau data and the account information to a risk model and electronically generating a score for the applicant from an output of the risk model; and determining whether to open the financial account based on the score", the Examiner respectfully disagrees. As discussed in the rejection Basch discloses inputting the credit bureau data and the account information to a risk model, electronically generating a score for the applicant from an output of the risk model and determining whether to open the financial account based on the score. (See the entire document of Basch especially Figure 1 Column 5 lines 11-16, 21-29, Column 6 line 64 - Column 8 line 2 and Column 9 lines 22-37). Basch receives credit bureau data (See the entire document of Basch especially Column 7 lines 64-66) and account information (See the entire document of Basch especially Column 7 lines 15-29) which are input to the Financial risk prediction system (FRPS). Scores are generated using the predictive models already created by the system and scores are used to make decisions including opening new credit accounts. Determining whether to open the financial account based on a score is also taught by Walker. Hence Basch in combination with Walker teaches all the limitations of the claimed invention.

Applicant's other arguments with respect to pending claims have been considered but are not persuasive.

***Conclusion***

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Narayanswamy Subramanian whose telephone number is (571) 272-6751. The examiner can normally be reached Monday-Thursday from 8:30 AM to 7:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached at (571) 272-6771. The fax number for Formal or Official faxes and Draft to the Patent Office is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PMR or Public PAIR. Status information for unpublished applications is available through Private PMR only. For more information about the PMR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Narayanswamy Subramanian/  
Primary Examiner  
Art Unit 3695

September 30, 2008